

REMARKS

Claims 1-12, 16-22, 29-31, 33-35 and 38 are pending and under examination.

Claim 35 is amended.

1. Rejection under 35 U.S. C. § 112, first paragraph

Claim 35 is rejected as not being enabled for "a pharmaceutical composition comprising the epithelial tumor cell." The Examiner acknowledges that the specification is enabled for a composition comprising an epithelial tumor cell of claim 1 and a pharmaceutically acceptable carrier. Although Applicants do not agree with the Examiner's basis for this rejection, claim 35 is amended to claim a method of treatment using the composition of claim 33. It is requested that this rejection be withdrawn.

2. Rejection under 35 U.S. C. § 102

The Examiner maintains the rejection of claims 1-3, 6-10, 16-19, 21 and 22 and newly added claim 38 as being anticipated by Garcia *et al* ("Garcia"). The Examiner maintains this rejection because she believes that Applicants are arguing that there is a distinction between the presently claimed immortalized epithelial tumor cells with metastatic potential and the cells of Garcia based upon the method by which they are made. Applicants respectfully disagree with the Examiner's characterization of Applicants' arguments. Applicants were merely highlighting the experiments that Garcia performed with the normal epithelial cells. The Examiner maintains that Garcia does disclose autologous, disseminated immortalized rabbit mammary epithelial tumor cells with metastatic potential which contains the large T antigen of non-infectious SV40 DNA.

Applicants maintain that Garcia does not disclose an immortalized epithelial tumor cell with metastatic potential. However, Garcia, on page 1974 in the abstract, in lines 6-7, states:

"...The cells were tumorigenic in nude mice, but had no metastatic potential." (emphasis added)

Further in Garcia, on page 1979, second column, lines 14-16, in discussing the tumorigenicity of the two mammary cell lines, Garcia states:

"In tumor-bearing animals, no metastases were detected by histological examination of regional lymph nodes and lungs." (emphasis added)

In reviewing these passages of Garcia, it is unclear how the Examiner can maintain her position that Garcia discloses epithelial tumor cells with metastatic potential when Garcia states otherwise.

In further support of Applicants' position that the epithelial cells of the present invention possess metastatic potential, Example 6, on pages 25-26 of the specification shows that immortalized cells which were derived from human metastatic lung cancer and prostate cancer do maintain the metastatic potential when injected into SCID mice. Specifically, in the first paragraph of Example 6, the present application recites:

Subcutaneous transplanatation of one of the immortalized micrometastatic lung cancer cell lines into immunodeficient SCID mice resulted in the development of local tumor growth and micrometastatic bone marrow infiltration at a frequency of 10^{-4} . Such minimal marrow infiltration was also observed with another line of immortalized prostate cancer cells when a subcutaneous tumor was not detectable.

These results provided from the present invention show that the cells of the present application have metastatic potential and the passages highlighted in Garcia show that the cells of Garcia do not have metastatic potential.

The Examiner is reminded that for a reference to anticipate a claim, it must meet disclose the features of the claimed invention. The case law supports this position. "[T]o constitute an anticipation, all material elements recited in a claim must be found in one unit of prior art." *In re Marshall*, 578 F.2d 301, 198 USPQ 344 (CCPA 1978). Further, an invention lacks novelty under 35 U.S.C. §102 if each and every element of the claim is described or disclosed, either explicitly or inherently, in a single prior art reference. *Finnigan Corp. v. International Trade Com'n*, 180 F.3d 1354, 1365 (Fed. Cir. 1999); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987). Such a reference is said to "anticipate" the invention, which renders the implicated claim invalid. Applicants assert that the Examiner has failed to show that Garcia anticipates the claimed invention.

In view of the disclosures in Garcia, Applicants maintain that Garcia does not anticipate the rejected claims, and it is requested that this rejection be withdrawn.

3. Rejection under 35 U.S. C. § 103

3.1 Claims 1, 4, 5, and 16-20

Claims 1, 4, 5 and 16-20 are alleged to be obvious over Garcia in view of Schlimok *et al.* ("Schlimok") and Yanagihara *et al.* ("Yanagihara"). The Examiner applies Garcia as above, and maintains the rejection over Schlimok and Yanagihara for the reasons set forth in the previous office action. In view of the arguments above that Garcia does not teach the epithelial tumor cell of claim 1; i.e., an immortalized epithelial tumor cell with metastatic potential, Applicants contend that this rejection cannot be maintained because the secondary references do not cure the deficiencies of Garcia. None of the cited prior art disclose or suggest the cell of claim 1.

As argued in the previous response, Applicants respectfully disagree with the Examiner's rationale for combining the cited prior art. The Examiner has failed to show all of the recited claim elements in the combination of references that make up the rejection. When combining elements to make out a *prima facie* case of obviousness, the Examiner is obliged to show by reference to specific evidence in the cited references that there was (i) a suggestion to make the combination and (ii) a reasonable expectation that the combination would succeed. Both the suggestion and reasonable expectation must be found within the prior art, and not be gleaned from Applicants' disclosure. *In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *In re Dow Chemical Co.*, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). The Examiner has failed to support the alleged case of *prima facie* obviousness, and as a result of these deficiencies, it is requested that this rejection be withdrawn.

3.2 Claims 1, 11, 12, 16, 29 and 30

Claims 1, 11, 12, 16, 29 and 30 are alleged to be obvious over Garcia in view of Blankenstein *et al.* ("Blankenstein"). The Examiner applies Garcia as above, and as argued above, it is Applicants' position that Garcia does not disclose the claimed cells nor does Garcia suggest, in combination with the teaching of Blankenstein, the claimed cells that possess metastatic potential. Again, the person skilled in the art would not have combined this reference with Garcia in order to arrive at the claimed subject matter. There is no motivation within the prior art cited to suggest Applicants' claimed invention. For these reasons, it is requested that this rejection be withdrawn.

3.3 Claims 1, 16-19, 21 and 31

Claims 1, 11, 12, 16, 29 and 30 are alleged to be obvious over Garcia in view of the Sigma Cell Culture Catalogue and Price List ("Sigma"). The Examiner applies Garcia and Sigma as above, and in the previous office action. For all of the reasons argued above, the subject matter of claims 1, 16-19, 21 and 31 are not obvious, and it is requested that this rejection be withdrawn in view of the arguments presented above regarding the novelty and nonobviousness of Garcia.

3.4 Claims 1, 33 and 34

Claims 1, 33 and 34 are alleged to be obvious over Garcia in view of Gottlinger *et al.* ("Gottlinger"). The Examiner applies Garcia as above, in combination with Gottlinger. Gottlinger provides no motivation to combine its teachings with Garcia. In view of these arguments and the arguments made above supporting the novelty and nonobviousness of Garcia, and the case law supporting nonobviousness of the present invention, it is requested that this rejection be withdrawn.

CONCLUSION

Applicants kindly request entry of this amendment as the amendment to claim 35 was suggested by the Examiner and does not raise any new issues. Applicants submit that this application is in condition for allowance, and they solicit an early indication to that effect. Should the Examiner believe that further discussion of any remaining issues would advance the prosecution, a telephone call to the undersigned, at the telephone number listed below, is courteously invited.

Respectfully submitted,

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Date

Jayne A. Huleatt
Jayne A. Huleatt
Reg. No. 34,485

FOLEY & LARDNER
3000 K Street, N.W.
Suite 500
Washington, D. C. 20007-5109
(202) 672-5300